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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/924,270 | 08/07/2001 | Kenji Takahashi | MM4461 | 4894 |

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2653

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,270

Applicant(s)

TAKAHASHI ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's response of 12/10/02 has been considered with the following results.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4,6-7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Applicant's arguments imply that the invention is that the claimed projections are on both the lateral sides of the lens holder and the surface of the suspension holder. However, such is not positively claimed in the above claims.

4. In the event that the examiner is misconstruing applicant's arguments, the following art rejections are made. ✓

- ✓ 5. As amended, claim 1 is drawn to fig. 13, one embodiment, while claims 2-7 are drawn to fig. 5 another embodiment. No restriction is given, e.g. different species since the examiner concludes these to be obvious variants over each other.

6. AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS, the following rejections are made.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2,4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by either Masunaga, Tomita et al ('661), Song, or the acknowledge prior art, figure 1 as depicted in US publication 2001-0028628 as it is supported by the priority document JP 2000-32507. With respect to the independent claim, the above documents depict a protrusion/projection at various locations: ✓

- a) Masunaga, see fig. 2 the "wings" protruding on either side of element 147
- b). Tomita ('661) see fig. 9-12 with respect to the projections depicted thereon
- c) Song – see figure 2 and its description of elements 144.
- d) Fig. 1 depicted in US pub. 2001/0028628 which is identified as prior art (conventional), US pub. Claims priority to JP 2000-32507.

As far as the examiner interprets applicants' termed projections, the above documents meet this limitation. The remaining claimed elements are self-evident.

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The limitations of claim 4 follow, i. e., a total of four projections. Furthermore, as best as examiner can interpret from the above documents, the limitations of claim 7 follow, the outer surfaces of these projections project from the lens holder approximately the same distance.

Response to Arguments

12. Applicant's arguments filed 12/10/02 have been fully considered but they are not persuasive. Applicant's claims recited alternative capabilities, that is as interpreted the projections are on either the frame, or the suspension holder not both.

With respect to Masunaga, the wings of the lens holder (see figure 2 again) are interpreted to be the first and second projections, with the upper set interpreted as meeting the claimed second projections, i.e., closer to the recording surface of the record medium than the other set of wings. The wherein clause is interpreted to follow from the elements positively recited in the remainder of the claim and hence inherently follows since the structure is met.

With respect to Tomita et al – again see figure 1, wherein the wing structure is depicted as part of the lens holder. Again, the upper wings are interpreted as the second projections and the wherein clause follows accordingly.

With respect to Song, applicant's attention is drawn to figures 1 and 2, wherein the protrusions 44, and 144 are interpreted as the first and second projections, and the upper wings as the claimed second projects. The limitations found in the wherein clause follow.

With respect to the conventional/prior art figure 1 as depicted in US publication 2001/0028628. Since this document relies upon JP priority document 2000-32507, the examiner interprets that the JP document also has figure 1 therein and as such, this figure is the acknowledged conventional system (prior art). Note elements 9 (four) upper and lower wherein the upper elements are interpreted as the claimed second projections.

13. Claim 3 are rejected under 35 U.S.C. 103(a) as obvious over the cited documents above with respect to claim 1 further considered with JP 62-031036.

With respect to claim 3, the position defined is considered evident in the JP document.

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The examiner interprets the limitations of claim 3 as a relocation of the projections, i.e., a relocation of parts, and obvious to one of ordinary skill in the art, since the function would still be retained.

The positioning of the projections would be a matter of choice by the manufacturer of the lens holder, as part of any molding technique. No unexpected results/or criticality is seen to occur from relocating these projections.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Wada et al.

Selection of elastic elements as defined in claim 6 is taught by the Wada et al reference.

Substituting such for the elastic members in any of the above noted prior art systems are merely a selection of equivalents with no unexpected results occurring from such a substitution.

15. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as stated above with respect to claim 2.

Claim 1 differs from claim 2 in that it recites that the projections are either at the surface of the frame or the suspension holder.

As noted above, the projections found in the prior art are found as part/ or on the lateral face of the lens holder. To relocate the projection(s) onto the frame, as opposed to the lens holder is considered an obvious variant thereof, which is forming a frame that surrounds the lens holder with the projection(s), as opposed to the lens holder having the projections thereon. No unexpected results/criticality is seen from such a relocation of the projections.

Allowable Subject Matter

16. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

JP 8-315388 & JP 11-306560 are cited as illustrative of alternative prior art "wings" configuration with respect to the lens holder in this environment.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiries concerning missing papers/references, etc. must be directed to: Group 2600 Customer Services at (703) 306-0377.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is: (703) 305-4700.

Any inquiry concerning the merits of this communication or earlier communication from the examiner should be directed to Aristotelis M. Psitos whose telephone number is: (703) 308-1598. The examiner can normally be reached on Monday-Thursday 8-4 EST. Messages can be left on the recording device.

If attempts to reach the examiner, or any of the above telephone contact points are unsuccessful, the examiner's supervisor, W. Korzuch can be reached on: (703) 305-6137.

The FAX number for the organization where this application or proceeding is assigned is: (703) 872-9314.

Aristotelis M. Psitos
Senior Primary Patent Examiner
Art Unit 2653



AMP
February 19, 2003